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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,146	03/29/2001	James Thomas Edward McDonnell	30003028 US	4257

7590

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EXAMINER

NGUYEN, LEE

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 03/09/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,146

Applicant(s)

MCDONNELL ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-4</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The IDS filed 3/29/2001, 5/6/2003 have been considered and recorded in the file.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9, 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Rautila et al. (US 6,549,625).

Regarding claim 1, Rautila teaches a method of gathering information from short-range wireless portals, comprising the steps of:

- (a) physically moving a mobile device 12 (fig. 1) within range of a short-range wireless portal 16 (col. 9, lines 12-15);
- (b) receiving information from the portal about the services available through the local entity operating the portal (col. 9, lines 15-20);
- (c) sending a message containing that information to a remote database service system 26 holding similar information from other portals (col. 9, lines 22-24); and

(d) storing the information at the database service system (col. 9, lines 24-29).

Regarding claim 2, Rautila also teaches that said message also contains the location of the portal, this location being stored with said information in the database service system whereby to permit location-based searching of the database system for entities providing specified types of service (col. 7, lines 22-42).

Regarding claim 3, Rautila further teaches that the location of the portal is provided to the mobile device by the portal itself (col. 7, lines 22-41).

Regarding claim 4, Rautila also teaches that the location of the portal is determined by the mobile device at the time of contact with the portal (col. 7, lines 32-37).

Regarding claim 5, Rautila also teaches that the message is passed to the mobile device to the database service system over a mobile cellular radio infrastructure (col. 8, lines 48-52).

Regarding claim 6, Rautila also teaches that upon receipt of said message the database service system obtains the location of the mobile device from a location server of the mobile radio infrastructure, this location

being stored with said information in the database service system whereby to permit location-based searching of the database system for entities providing specified types of service (col. 7, lines 12-41).

Regarding claim 7, Rautila also teaches that said information is stored in the mobile device and the message containing this information is sent to the database service system at a later time by any appropriate means including by e-mail or by a web-based form sent over the internet (col. 3, lines 45-48 and 60-64).

Regarding claim 8, Rautila further teaches that the database service system acknowledges receipt of the message and this acknowledgement is transmitted back to the portal where an indicator is set, this indicator when set being used to prevent further messages being sent to the database service system by the same or similar mobile devices that subsequently obtain information from the portal (col. 7, lines 5-10).

Regarding claim 9, Rautila inherently teaches that the indicator is reset by the local entity operating the portal when there is a change in the information available from the portal (the postal 14 will reset after providing services to the mobile device 12).

Regarding claim 12, Rautila also teaches URL (col. 7, line 41).

Regarding claim 13, Rautila teaches a mobile device (figs 1-2), comprising:

a short-range wireless receiver 44 (fig. 2) for receiving information from a short-range wireless portal 16 (fig. 1) about the services available through the local entity operating the portal; means 48 for forming a message containing that information together with location data about the location of the portal (col. 8, lines 52-62); and a cellular radio subsystem 46 for sending the message to a remote database service 26 (fig. 1) system over a mobile radio infrastructure 42 (fig. 1).

Regarding claim 14, Rautila also teaches means for receiving an acknowledgement back from the database service system and for passing this acknowledgment to the portal (col. 7, lines 5-10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila et al.

Regarding claim 11, Rautila fails to teach that the storing in the database service system of the information about the services available from the local entity associated with the portal, results in the user of the mobile device being recorded a reward. One having skilled in the art would recognize that the results in the user of the mobile device being recorded a reward is just first, a design choice, second an intended use of doing business. This limitation is considered not critical to the claimed invention.

And a skilled artisan at the time the invention was made could have applied this design choice to the invention.

Allowable Subject Matter

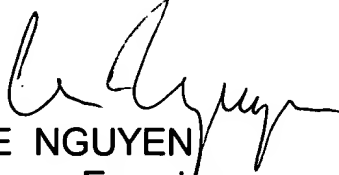
9. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 10, the prior art of record fails to teach that the database service system has an associated identifier which is stored with said indicator and is used to restrict the action of preventing repeat message sends, to resends to the database service system indicated by said identifier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 3/6/04
LEE NGUYEN
Primary Examiner
Art Unit 2682